

REMARKS

Claims 75-90 are pending in this application. Claims 1-74 have been canceled without prejudice or disclaimer. Claims 89-90 have been withdrawn as directed to non-elected subject matter.

The specification has been amended to correct minor informalities. Specifically, in the paragraph beginning on page 3, line 27 and ending on page 4, line 1, the browser executable code "http://" has been deleted without prejudice or disclaimer. Additionally, the tradename "EMBRYOGUARDTM" has been capitalized throughout the specification.

No new matter has been added.

In view of the remarks set forth below, further and favorable consideration is respectfully requested.

I. At page 3 of the Official Action, the specification has been objected to as containing informalities.

Specifically, the Examiner asserts that the specification requires correction because browser executable code appears on page 4. Additionally, the Examiner asserts that the specification requires correction because the use of the tradename "EMBRYOGUARD" should be capitalized wherever it appears in the specification.

Applicants respectfully traverse this objection.

As discussed, the specification has been amended as requested by the Examiner. Specifically, in the paragraph beginning on page 3, line 27 and ending on page 4, line 1, the browser executable code "http://" has been deleted without

prejudice or disclaimer. Additionally, the tradename "EMBRYOGUARDTM" has been capitalized through the specification.

In view of the foregoing, it is submitted that present specification fully complies with the requirements set forth in MPEP § 608.01. Accordingly, the Examiner is respectfully requested to withdraw this objection.

II. At page 5 of the Official Action, claims 75-88 have been rejected under 35 USC § 103(a) as being unpatentable over Gianaroli et al. (Human Reproduction, Vol. 15, No. 10, pp. 2241-2246, 2000), in view of Whisler et al. (Clinical Chemistry, Vol. 36, No. 9, p. 1587-1588, 1990).

The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the procedures of processing IVF components of Gianaroli et al. with the use of barcodes for medical specimen processing in Whisler et al.

Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, the PTO must satisfy three requirements. First, as the U.S. Supreme Court very recently held in *KSR International Co. v. Teleflex Inc. et al.*, *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), "a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. ...it [may] be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. ...it can be important to identify a reason that would have

prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." (*KSR, supra*, slip opinion at 13-15.) Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

Regarding motivation to modify a reference, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. See *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d 680 at 682.

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). In addition, if a proposed modification or combination of prior art references would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959).

It is submitted that a *prima facie* case of obviousness has not been established because nothing in any of the applied references, taken alone or together, teach or suggest all of the limitations of the claims as required by *In re Wilson*.

Independent claim 75 is directed to a method for use in controlling the processing of components that are involved in in vitro fertilization (IVF), the method comprising: defining a matching set of two or more components to be involved in a common IVF process; assigning each component with a unique machine readable identification mark; providing on each component the unique machine readable identification mark assigned to said component; and reading the identification mark on each component, generating data indicative thereof; and analyzing the generated data to determine whether the identification marks of said components belong to said matching set or not. Claims 76-88 depend, either directly or indirectly, from claim 75.

In contrast, Gianaroli et al. describe guidelines drafted by the Embryology Special Interest Group aimed at giving support and guidance to laboratory staff. However, in contrast to the presently pending claims, Gianoli et al. do not teach or suggest a method for use in controlling the processing of components that are involved in in vitro fertilization (IVF), the method comprising: defining a matching set of two or more components to be involved in a common IVF process; assigning each component with a unique machine readable identification mark; providing on each component the unique machine readable identification mark assigned to said component; and reading the identification mark on each component, generating data

indicative thereof; and analyzing the generated data to determine whether the identification marks of said components belong to said matching set or not.

Whisler et al. do not remedy the deficiencies of Gianaroli et al. Whisler et al. is directed to a device for handling specimens. Like Gianaroli et al., Whisler et al. do not teach or suggest a method for use in controlling the processing of components that are involved in in vitro fertilization (IVF), the method comprising: defining a matching set of two or more components to be involved in a common IVF process; assigning each component with a unique machine readable identification mark; providing on each component the unique machine readable identification mark assigned to said component; and reading the identification mark on each component, generating data indicative thereof; and analyzing the generated data to determine whether the identification marks of said components belong to said matching set or not. Therefore, Applicants respectfully submit that, whether taken alone or in combination, Gianaroli et al. and Whisler et al. do not teach or suggest every element of the presently pending claims.

In view of the remarks set forth herein, it is submitted that, whether taken alone or in combination, Gianaroli et al. and Whisler et al. do not render claims 75-88 obvious within the meaning of 35 USC § 103 (a). Accordingly, the Examiner is respectfully requested to withdraw this rejection.

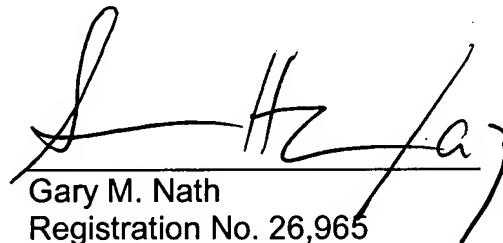
Conclusion

In view of the foregoing, Applicants submit that the application is in condition for immediate allowance. Early notice to that effect is earnestly solicited. The Examiner is invited to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

THE NATH LAW GROUP

A handwritten signature in black ink, appearing to read 'G. Nath', is written over a horizontal line.

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